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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,315	10/24/2003	Takao Abe	AM100905P1	1495
25291	7590	10/27/2008		
WYETH PATENT LAW GROUP 5 GIRALDA FARMS MADISON, NJ 07940			EXAMINER BERCH, MARK L	
			ART UNIT 1624	PAPER NUMBER
			MAIL DATE 10/27/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DETAILED ACTION

The traverse is unpersuasive.

Applicants quote *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197, 14 S.Ct. 310, 38 L.Ed. 121 (1894) as stating that "a single invention may include both the machine and the manufacture it creates, and in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each."

The key phrase is "if the inventions are really separable". To do this, applicants must establish the alternative method. In this regard, applicants have cited *Takeda Pharmaceutical Co., Ltd. v. Dudas*, 84 U.S.P.Q.2d 1365. This case dealt with various aspects of this standard, especially the issues of whether the Court would consider a new affidavit, and whether there is a "requirement that this alternative process have been known as of the filing date." But underlying this is still the requirement that there be "alternative processes for making the compounds". Instead, applicants point to a different standard, whether or not there are "generally conventional methods for making the compounds", drawing from dicta in *Ex parte MacAdams*. That is not the correct standard. Applicants state, "Applicants method was the result of extensive research, and is not obvious merely from knowledge of the compound to be made." Of course, this is true; if it were not, then a rejection under 35 USC 103 or 102 would have been made, but that is not the standard. Applicants have not only not demonstrated that there is another method, they have not even asserted this.

Applicants state: "The Examiner also states that it does not matter whether the compound claim or the process claim is patented first. Applicants strongly disagree. A

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process for making compound X must disclose compound X, but a claim to compound X need not disclose a process.”

This entirely misses the point of the obviousness-type Double patenting rejection, which is the improper extension of monopoly, i.e. "to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent”, or, as worded in the Takeda case, which also had the compounds in the first patent, “the focus should be on whether the second patent unjustly extends the patent rights of a first patent.” This principle goes back to *In re Zickendraht*, 138 USPQ 22, 27 and *In re Van Ornum*, 214 USPQ 761. The improper extension of monopoly will occur regardless of sequence.

Applicants brush aside *Geneva Pharmaceuticals*, and *In re Boylan*, which relate to methods of using rather than methods of making (as did *Ex parte MacAdams*), saying “they are different. The Examiner has erroneously used a rote analysis, rather than applying the proper standard for obviousness.” This is not persuasive. Methods are methods, regardless of whether these are methods of use or methods of making. The examiner sees no reason why the difference is in any way relevant, and applicants have cited no case law saying these should be treated differently. See in this regard *In re Bridgeford*, 149 USPQ 55, where it was established that the two formats make no difference in a Double Patenting context.

Applicants also state, “The Examiner has cited *In re Freeman*, in which product claims were found to be obvious based on process claims. However, in that case the product was defined by the process, i.e., they were product by process claims; this is not the case here.” Agreed, but again, why should the format in which the composition of matter is claimed have any impact on the application of law? The examiner sees no reason why, and

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the examiner must note that In re Byck, 9 USPQ 205 did not have product-by-process language, and had the same result as In re Freeman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663.

The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner
Art Unit 1624

10/25/2008

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/693,315	Applicant(s) ABE ET AL.	
	Examiner /Mark L. Berch/	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 9-11, 13-30 and 32-40.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See memo.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Mark L. Berch/
 Primary Examiner
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